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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,125	05/19/2006	Iris Biermann	2209.948(WS2243 US-PCT)	7509
21878 7590 11/14/2007 KENNEDY COVINGTON LOBDELL & HICKMAN, LLP 214 N. TRYON STREET HEARST TOWER, 47TH FLOOR CHARLOTTE, NC 28202			EXAMINER HURLEY, SHAUN R	
			ART UNIT	PAPER NUMBER
			3765	
			MAIL DATE	DELIVERY MODE
			11/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

CT

Office Action Summary	Application No.		Applicant(s)	
	10/580,125		BIERMANN ET AL.	
	Examiner		Art Unit	
	Shaun R. Hurley		3765	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/19/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). It should be noted that while Examiner can see figures which appear to align with Applicant's description, in his foreign priority documents, Examiner cannot properly assume these are the identical drawings which are currently omitted. Examiner will note, however, that if they are identical, there are no errors. In any instance, Applicant should provide the omitted drawings for Examiner's review.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3765

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by

Wassenhoven et al (5509261).

5. Wassenhoven teaches an effect yarn formed of alternating webs and effects formed by utilizing a rotor spinning machine and variation of a draw in motor (Figures; Column 7, lines 12-35), wherein during production, a piecing step may occur by a piecing unit displaced along the rotor spinning machine (20). In regards to an effect formation being formed during piecing, it is Examiner's opinion that the piecing would be an effect. In regards to the resultant product, it is Examiner's opinion that this is product-by-process, and Applicant is reminded that in assessing the subject matter of product-by-process claims, it is necessary to bear in mind certain principles. Foremost among these is the principle that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Brown, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969). Thus, the patentability of a product does not depend on the method of production. Thorpe, supra. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Thorpe, supra; In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983). The Court of Customs and Patent Appeals discussed these principles as well as the rationale for rejection of such claims over prior art disclosures of products in In re Brown, 459 F.2d 531, 173 USPQ 685 (CCPA 1972) as follows:

Art Unit: 3765

In order to be patentable, a product must be novel, useful and unobvious. In our law, this is true whether the product is claimed by describing it, or by listing the process steps used to obtain it. This latter type of claim, usually called a product-by-process claim, does not inherently conflict with the second paragraph of 35 USC 112. [citation omitted] That method of claiming is therefore a perfectly acceptable one so long as the claims particularly point out and distinctly claim the product or genus of products for which protection is sought and satisfy the other requirements of the statute. It must be admitted, however, that the lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. (emphasis in the original, footnotes omitted).

Thus, although process limitations distinguishing the product over the prior art must be given the same consideration as traditional product characteristics, In re Hallman, 655 F.2d 212, 210 USPQ 609 (CCPA 1981), In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1973), and although product-by-process claims are limited by and defined by the process, determination of patentability remains based upon the product itself, Thorpe, 227 USPQ at 966.

In view of the similarities between the claimed process, i.e. "piecing", and that of the prior art of Wassenhoven, it is reasonable to believe that the product made by the prior art process would be either identical to or only slightly different from the claimed product. In such a situation, the burden of proof shifts to applicant to prove that the claimed product is materially different. If Applicant's invention is to produce a piecing that matches the previous effect, than this would be anticipated by an unpieced yarn. And if Applicant's invention is to produce a piecing that has any effect, this would be anticipated by any piecing, diameter would not matter.

Art Unit: 3765

Conclusion


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Raasch et al (4825632) and Brandl et al (7082746) both teach what is well known in the art.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaun R. Hurley whose telephone number is (571) 272-4986.

The examiner can normally be reached on Mon - Fri, 8:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Shaun R Hurley
Primary Examiner
Art Unit 3765

SRH
09 November 2007